



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Appellant: Gary L. Bennis

Attorney file: 5437cp

Serial No.: 09/766,032

Examiner: Rowan, Kurt C.

Filed: 01/19/2001

Group: 3643

For: TWO-STAGE FISHING BOBBER

**APPEAL BRIEF
COVER LETTER**

Honorable Commissioner for Patents

Alexandria, VA 22313-1450

Dear Sir:

Enclosed is an appeal brief that the Appellant is submitting for the above-identified patent application under 37 C.F.R. 1.17(C). The Appellant has included three (3) copies of the appeal brief along with a credit card authorization in the amount of \$250.00 for the Appeal Brief filing fee. The Appellant does not wish to request for an oral hearing. Please charge any deficiency in fees to deposit account 10-0210.

Appellant's attorney, Carl L. Johnson, certifies that three (3) copies the Appeal Brief is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 28, 2006.

My 11, 2006

Date

Carl Johnson

Carl L. Johnson

Respectfully submitted,

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Enclosure



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Serial No.: 09/766,032 Examiner: Rowan, Kurt C.
Filed: 01/19/2001 Group: 3643
For: TWO-STAGE FISHING BOBBER

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on May 11, 2006 by Appellant's attorney, Carl L. Johnson.

Carl L. Johnson

Carl E. Johnson

MAY 11, 2006

Date

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

APPELLANT'S APPEAL BRIEF

Sir:

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I. REAL PARTY IN INTEREST

The real party in interest is Gary L. Bennis, inventor of U.S. patent application serial number 09/766,032; filed on January 19, 2001; titled TWO-STAGE FISHING BOBBER.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the above-identified patent application.

III. STATUS OF CLAIMS

Claims 18, 19, and 22 to a two-stage fishing bobber responsive to different fishing forces are currently pending in the above-identified application. Claims 1-17 and 20-21 have been canceled from the application and thus are not a part of the present appeal.

IV. STATUS OF AMENDMENTS

The present application, currently comprising claims 18, 19, and 22, was rejected final on November 16, 2005. In response to the final rejection of November 16, 2005, a Notice of Appeal was filed on March 16, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellant's Independent claims 18 and 21 each stand alone on their own.. Although Appellant's claim 19 depends on independent claim 18, Appellant's claim 19 also stands on its own.

In regards to Appellant's claims 18, 19 and 21, Appellant's independent claim 18 calls for a two-stage fishing bobber responsive to different fishing forces with the fishing bobber having a bobber main body that provides a buoyant force to normally maintain the bobber main body in a floating condition and a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the resiliently displaceable member with respect to the bobber main body so as to provide gradual resistance. Support for Appellant's independent claim 18 can be found for example on page 7, lines 5-16; page 9, lines 6-20, and in Figure 4 of the Appellant's disclosure.

Appellant's dependent claim 19 calls for the two-stage fishing bobber responsive to different fishing forces of independent claim 18 wherein the force to displace the resiliently displaceable member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the resiliently displaceable member is in the down position the bobber main body is submerged. Support for Appellant's independent claim 19 can be found for example on page 7, lines 5-16; page 9, lines 6-20, page 12, lines 14-24 and in Figures 4 and 10 of the Appellant's disclosure.

Appellant's independent claim 22 calls for a two-stage fishing bobber responsive to different fishing forces with the fishing bobber having a bobber main body that provides a buoyant force to normally maintain the bobber main body in a floating condition and a

member resiliently displaceable with respect to the bobber main body in response to a force on the member with the force on the member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance. Support for Appellant's independent claim 22 can be found for example on page 7, lines 5-16; page 9, lines 6-20, page 12, lines 14-24 and in Figures 4 and 10 of the Appellant's disclosure.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether the reference of Riead teaches a fishing bobber that includes a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to a bobber main body being approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the resiliently displaceable member with respect to the bobber main body so as to provide gradual resistance?
2. Whether the reference of Riead teaches a fishing bobber having a force to displace a resiliently displaceable member to a down position as being substantially equal to the buoyant force of a bobber main body so that the when the resiliently displaceable member is in the down position the bobber main body is submerged?

3. Whether the reference of Riead teaches a fishing bobber having a member resiliently displaceable with respect to a bobber main body in response to a force on the member with the force on the member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance?

VII. ARGUMENT

Brief History of the Case

The Appellant respectfully directs attention to the following summary of the present application. On May 29, 2002, the Appellant received a non-final Office Action in which the Examiner rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram (U.S. Patent No. 2,500,078). On November 12, 2002, the Appellant received a Final Office Action in which the Examiner maintained the Examiner's rejections of May 29, 2002.

On May 1, 2003, the Appellant received a Final Office Action in which the Examiner then rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Kotis (U.S. Patent No. 3,196,575). It is noted that independent claim 18 had not been amended in any of the Appellant's previous responses to the Examiner's rejection. On September 9, 2003, the Appellant received a Final Office Action in which the Examiner maintained the Examiner's rejections of May 1, 2003.

On May 19, 2004, the Appellant received a non-final Office Action in which the Examiner then rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Kotis and as being anticipated by the reference of Ingram. It is noted that independent claim 18 had not been amended in any of the Appellant's previous responses to the Examiner's rejection.

On January 13, 2005, the Appellant received a Final Office Action wherein the Examiner switched back to the Examiner's original rejection by again rejecting Appellant claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram. It is noted that independent claim 18 had not been amended in any of the Appellant's previous responses to the Examiner's rejection.

On June 6, 2005, the Appellant received a non- Office Action wherein the Examiner rejected Appellant's independent claims 18 and 21 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram. The Examiner however stated that dependent claim 20 "...would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (Page 3, lines 19-21 of the Office Action June 6, 2005.) In view of the Examiner's statement and in order to place the Application in a condition for allowance, the Appellant amended independent claim 18. It is noted that the aforementioned was the first time that Appellant's independent claim 18 was amended.

On November 16, 2005, the Appellant received a Final Office Action wherein the Examiner further changed the Examiner's rejection by rejecting Appellant's claims 18-19 and 21 under

35 U.S.C. 102(b) as being anticipated by the reference of Ried (U.S. Patent No. 4,461,114). The Appellant respectfully submits that the Appellant's previous and only amendment to independent claim 18 was predicated on the Examiner's statement on the allowability of Applicant's claim 20 in order to place the Application in a condition for allowance

1. **The reference of Ried does not teach a fishing bobber that includes a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to a bobber main body being approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.**

Appellant's claims 18 and 19 stands rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Ried (U.S. Patent No. 4,461,114). In regards to Appellant's 18 and 19, Appellant's 18 and 19 each calls for a two-stage fishing bobber responsive to different fishing forces, the fishing bobber including:

“... a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” (Emphasis added.)

On page 2, lines 20-25 and page 3, lines 1-4 of the Final Office Action dated November 16, 2005, in support of the Examiner's rejection of Appellant's claims 18 and 19, the Examiner stated:

"The patent to Riead shows a bobber in Fig. 1 having a main body 2 providing a buoyant force to normally maintain the bobber main body in a floating condition and a spring 64 having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member 62 to allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance as disclosed in column 5, lines 1-25." (Emphasis added.)

The Appellant respectfully but strenuously disagrees with the Examiner's above statement. More specifically, the Appellant respectfully submits that the reference of Riead does not show Riead's spring 64 as having a spring constant to compress Riead's spring 64 with respect to Riead's bobber main body 2 being approximately equal to the total force to submerge the bobber main body 2 and Riead's washer 62 "...to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance ..." as called for in Appellant's claims 18 and 19.

Instead, attention is directed to column 5, lines 1-25 wherein Riead specifically teaches his spring 64 as having a tension that provides sufficiently sensitivity to his lamp switch 40 so that:

“...the lamp will be lighted by an additional leader load less than that required to submerge the float completely.” (Emphasis added.)

It is respectfully submitted that by teaching that the compression of Riead’s spring 64, which leads to the lighting of Riead’s lamp by an additional leader load less than that required to submerge the float completely, that the reference of Riead further does not teach the subject matter of Appellant’s independent claims 18 and 19 as the reference of Riead does not provide for the “... simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.”

It is for the above reasons that the Appellant respectfully submits that the reference of Riead does not teach a fishing bobber that includes a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to a bobber main body being approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance as called for in Appellant’s claims 18 and 19.

2. **The reference of Riead does not teach a fishing bobber having a force to displace a resiliently displaceable member to a down position as being substantially equal to the buoyant force of a bobber main body so that the when the resiliently displaceable member is in the down position the bobber main body is submerged.**

Appellant's dependent claim 19 currently stands rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Riead (U.S. Patent No. 4,461,114). Appellant's dependent claim 19 calls for the fishing bobber of claim 18:

“...wherein the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.” (Emphasis added.)

The Appellant respectfully submits that the reference of Riead does not teach a force to displace Riead's washer 62, which the Examiner asserts is equivalent to the displacement member of Appellant's claim 19 (see page 3, lines 1-4 of the Final Office Action dated November 16, 2005), as being substantially equal to the buoyant force of Riead's body 2 so that when Riead's washer 62 is in the down position Riead's body 2 is submerged. Instead, it is respectfully submitted that the reference of Riead specifically teaches the opposite in column 5, lines 1-25, namely that Riead's washer 62 is first displaced without the submergence of Riead's body 2 to light Riead's lamp in order to provide a visual signal to the fisherman that a fish has taken the bait. The Appellant respectfully submits that only after then does Riead's body 2 submerges. Further support for the aforementioned can be specifically found in column 5, lines 10-12 wherein Riead teaches that Riead's device would be “useless” if the washer 62 is displaced and the lamp is lighted after the float was submerge, i.e. “...when the member is in the down position the bobber main body is submerged...” as called for in Appellant's dependent claim 19.

It is for the above reasons that the Appellant respectfully submits that the reference of Ried does not teach a fishing bobber having a force to displace a resiliently displaceable member to a down position as being substantially equal to the buoyant force of a bobber main body so that the when the resiliently displaceable member is in the down position the bobber main body is submerged as called for in Appellant's claim 19.

3. **The reference of Ried does not teach a fishing bobber having a member resiliently displaceable with respect to a bobber main body in response to a force on the member with the force on the member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.**

Appellant's independent claim 22 stands rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Ried (U.S. Patent No. 4,461,114) in view of the Examiner's Office Actions dated November 16, 2005 and April 10, 2006.

Appellant's independent claim 22 calls for a two-stage fishing bobber that is responsive to different fishing forces, the two-stage fishing bobber having:

“...a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” (Emphasis added.)

It is respectfully submitted that the reference of Riead does not teach “... the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance...” as called for in Appellant’s independent claim 22. (Emphasis added.)

Referring to Riead’s Figure 2, the Appellant respectfully notes that Riead’s washer 62 (which the Examiner asserts on page 3, lines 1-4 of the Final Office Action dated November 16, 2005 is equivalent to the displacement member) is located and restricted within the interior of Riead’s fishing float proximal the mid-region of the Riead’s fishing float.

Referring to Figure 2, the Appellant further notes that the aforementioned position of Riead’s washer 62 is located below or underneath the body 2 of Riead’s fishing floats. The Appellant respectfully submits that since Riead’s washer 62 is located below the body 2 of Riead’s fishing float, the aforementioned location of Riead’s washer 62 would result in Riead’s washer 62 being submerged before Riead’s body 2 is submerged in a body of water.

Appellant’s independent claim 22 also calls for a fishing bobber that provides gradual resistance due to the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body. It is respectfully noted that the advantage of providing for a gradual resistance is that:

“... the fish does not notice the sharp resistance of the bobber as the bobber is submerged and is less likely to spit out the bait. That is instead of the fish facing an abrupt jerk on the line by submerging the bobber the fish receives a gradual pull on the line as the spring is compressed and then a further tug as the bobber is submerged. However, since there is already a resistance on the line from compressing the spring the submersion of the bobber does not produce a sharp increase in the force which might cause the fish to spit out the hook.” (Emphasis added, see page 14, lines 22-25 of the Appellant’s disclosure.)

It is respectfully submitted that since the reference of Riead does not teach “... the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body...” in view of the above, the Appellant respectfully submits that the reference of Riead also does not “provide gradual resistance...” as called for in Appellant’s independent claim 22. The Appellant respectfully submits that the reference of Riead is not even concerned with the advantage of providing for a gradual resistance for Riead’s fishing float.

The reference of Riead instead is directed to a fishing float that includes a lamp thereon, which lights when a fish takes the bait but before the fishing float submerges “... thereby giving the fisherman a signal that a fish has bitten, and that he should pull the line to set the hook and reel in the fish.” (Column 1, lines 10-15 of Riead.)

In regards to the Examiners comments on page 3, lines 1-4 of the Final dated November 16, 2005 that the reference of Riead discloses “gradual resistance” in column 5, lines 1-25, the Appellant strenuously but respectfully disagrees. The Appellant respectfully submits that the Appellant’s review of column 5, lines 1-25 of the reference of Riead failed to reveal the disclosure of “gradual resistance” for Riead’s fishing float. Riead’s column 5, lines 1-25

instead reiterated the purpose of Riead's device, namely to provide for a fishing float that includes a lamp thereon, which lights when a fish takes the bait but before the fishing float submerges. Note for example in column 5, lines 8-11 wherein Riead specifically states:

“...the sensitivity must be sufficiently great that the lamp will be lighted by an additional leader load less than that required to submerge the float completely.”
(Emphasis added.)

Also note in column 5, lines 15-18 wherein Riead further states that Riead's fishing float:

“... does not light under normal leader load, or under any normal and reasonable agitation of the float, but does light in response to a downward pull on the leader, before the float body submerges completely.” (Emphasis added.)

The Appellant respectfully submits that the lighting of a lamp on a fishing float when a fish takes the bait but before the fishing float submerges to give the “... fisherman a signal that a fish has bitten, and that he should pull the line to set the hook and reel in the fish...” is not related to “... the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance” as called for Appellant's independent claim 22.

It is for the above reason that the Appellant respectfully submits that the reference of Riead does not teach a fishing bobber having a member resiliently displaceable with respect to a bobber main body in response to a force on the member with the force on the member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the

displacement of the member with respect to the bobber main body so as to provide gradual resistance as called for in Appellant's independent claim 22.

In further regards to Appellant's claim 19, Appellant's dependent claim 19 depends on Appellant's independent claim 18. Since Appellant's independent claim 18 is allowable for the reasons given above, Appellant's dependent claim 19 should also be allowable.

It is for the above reasons that the Appellant respectfully submits that Appellant's claims 18, 19 and 22 are allowable over the prior art reference of Ried.

In summary, it is respectfully submitted that the Examiner was incorrect in rejecting Appellant's independent claims 18 and 22 and dependent claim 19 under 35 U.S.C. 102(b) as being anticipated by the reference of Ried (U.S. Patent No. 4,461,114). Accordingly, it is respectfully requested that the decision of the Examiner be reversed and that Appellant's claims 18, 19 and 22 be allowed.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

Claims involved in the appeal:

1-17. (Canceled)

18. (Previously Presented) A two-stage fishing bobber responsive to different fishing forces comprising:

a bobber main body, said bobber main body providing a buoyant force to normally maintain the bobber main body in a floating condition; and

a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.

19. (Previously Presented) The two stage fishing bobber of claim 18 wherein the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that when the member is in the down position the bobber main body is submerged.

20. (Canceled)

21. (Canceled)

22. (Previously Presented) A two-stage fishing bobber responsive to different fishing forces comprising:

a bobber main body, said bobber main body providing a buoyant force to normally maintain the bobber main body in a floating condition; and

a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDING APPENDIX

None